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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
YIGDALL, MICHAEL J	

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/783,553	SATOH, HIROTSUGU	
	Examiner	Art Unit	
	Michael J. Yigdall	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 February 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 February 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-5 are pending and have been examined. The priority date considered for the application is 28 February 2000.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,097,814 to Mochizuki.

With respect to claim 1, Mochizuki discloses an optical recording medium that is computer-readable and -writable (see column 5, lines 15-21, which shows a computer-readable optical recording medium; see also column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores software to be distributed, non-rewritable inherent ID information (see column 5, lines 29-35, which shows that the medium stores software to be distributed and inherent ID information; see also column 5, lines 56-67, which shows that the ID

is permanent, i.e. non-rewritable), and a transmission program for transmitting the inherent ID information to a software distributor via a communication device (see steps S1 and S4 in FIG. 4, and column 7, lines 3-10, which shows that the ID stored on the medium is transmitted to a software distributor).

With respect to claim 4, Mochizuki further discloses storing a computer information acquiring program for acquiring information of a computer that is currently using the optical recording medium (see column 6, lines 17-30, which shows obtaining a drive ID from the reproduction apparatus that is using the medium), wherein the transmission program transmits the information of the computer, as well as the inherent ID information, to the software distributor (see steps S1, S2 and S4 in FIG. 4, and column 7, lines 3-10, which shows transmitting the inherent ID of the medium and the drive ID or information of the computer to the software distributor).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki in view of U.S. Pat. No. 6,381,741 to Shaw.

With respect to claim 2, Mochizuki discloses an optical recording medium that is computer-readable and -writable (see column 5, lines 15-21, which shows a computer-readable optical recording medium; see also column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores software to be distributed and non-rewritable inherent ID information (see column 5, lines 29-35, which shows that the medium stores software to be distributed and inherent ID information; see also column 5, lines 56-67, which shows that the ID is permanent, i.e. non-rewritable).

Although Mochizuki discloses reproducing the software based on an authentication judgment result of the inherent ID information (see steps S1, S4, S8 and S9 in FIG. 4), Mochizuki does not expressly disclose a software updating program for rewriting and updating the software in accordance with update software transmitted from a software distributor via a communication device based on an authentication judgment result of the inherent ID information.

However, Shaw discloses an updater or updating program (see column 4, lines 44-49) for rewriting and updating software with updated code transmitted from a distributor (see column 5, lines 3-13), based on an authentication judgment result (see column 4, lines 34-42, which shows comparing a digital signature before beginning the update process), after first transmitting ID information (see column 4, lines 13-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with the rewriting and updating features taught by Shaw, for the purpose of enabling a secure update to the software (see Shaw, column 1, line 66 to column 2, line 10) before it is reproduced.

With respect to claim 3, Mochizuki discloses an optical recording medium that is computer-readable and -writable (see column 5, lines 15-21, which shows a computer-readable optical recording medium; see also column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores software to be distributed, non-rewritable inherent ID information (see column 5, lines 29-35, which shows that the medium stores software to be distributed and inherent ID information; see also column 5, lines 56-67, which shows that the ID is permanent, i.e. non-rewritable), and a transmission program for transmitting the inherent ID information to a software distributor via a communication device (see steps S1 and S4 in FIG. 4, and column 7, lines 3-10, which shows that the ID stored on the medium is transmitted to a software distributor).

Although Mochizuki discloses reproducing the software based on an authentication judgment result of the inherent ID information (see steps S1, S4, S8 and S9 in FIG. 4), Mochizuki does not expressly disclose a software updating program of rewriting and updating the software in accordance with update software transmitted from the software distributor via the communication device based on an authentication judgment result of the inherent ID information.

However, Shaw discloses an updater or updating program (see column 4, lines 44-49) for rewriting and updating software with updated code transmitted from a distributor (see column 5, lines 3-13), based on an authentication judgment result (see column 4, lines 34-42, which shows comparing a digital signature before beginning the update process), after first transmitting ID information (see column 4, lines 13-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with the rewriting and updating features taught by Shaw, for the purpose of enabling a secure update to the software (see Shaw, column 1, line 66 to column 2, line 10) before it is reproduced.

With respect to claim 5, Mochizuki discloses software distributed and stored in a computer-readable and -writable optical recording medium (see column 5, lines 15-21, which shows software distributed and stored in a computer-readable optical recording medium; see also column 9, line 56 to column 10, line 8, which shows that the medium is writable).

Although Mochizuki discloses a method for reproducing software (see the title and abstract), Mochizuki does not expressly disclose a method of updating software.

However, Shaw discloses a method of upgrading or updating software (see the title and abstract).

Mochizuki further discloses transmitting non-rewritable inherent ID information to a software distributor via a communication device (see steps S1 and S4 in FIG. 4, and column 7, lines 3-10, which shows that the ID stored on the medium is transmitted to a software distributor).

Although Mochizuki discloses reproducing the software based on an authentication judgment result of the inherent ID information (see steps S1, S4, S8 and S9 in FIG. 4), Mochizuki does not expressly disclose rewriting and updating the software in accordance with update software transmitted from the software distributor via the communication device based on an authentication judgment result of the inherent ID information.

However, Shaw further discloses an updater or updating program (see column 4, lines 44-49) for rewriting and updating software with updated code transmitted from a distributor (see column 5, lines 3-13), based on an authentication judgment result (see column 4, lines 34-42, which shows comparing a digital signature before beginning the update process), after first transmitting ID information (see column 4, lines 13-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with the rewriting and updating features taught by Shaw, for the purpose of enabling a secure update to the software (see Shaw, column 1, line 66 to column 2, line 10) before it is reproduced.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Pat. No. 6,094,723 to Otsuka discloses an optical recording medium for distributing software having a read-only portion and a rewritable portion. U.S. Pat. No. 6,080,207 to Kroening et al. discloses a method for customizing software and distributing it on recordable CD. U.S. Pat. No. 6,553,507 to Cohen discloses a method for automatically updating software when a problem or trouble is identified.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (703) 305-0352. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MY

Michael J. Yigdall
Examiner
Art Unit 2122

mjy
March 5, 2004

TUAN DAM
SUPERVISORY PATENT EXAMINER